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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,895	08/02/2001	Peter A. Goode	22.1410	9846

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14910 AIRLINE ROAD
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EXAMINER

BEACH, THOMAS A

ART UNIT	PAPER NUMBER
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3671

NOTIFICATION DATE	DELIVERY MODE
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09/21/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/920,895	Applicant(s) GOODE ET AL.	
	Examiner THOMAS A. BEACH	Art Unit 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12, 25-29 and 44-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-12, 25-29 and 44-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10-11, 26, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. 6,302,199 in view of Kilgore 6,182,765. Hawkins shows a method including the method of halting the flow of fluid in a well (col. 2, lines 31-40); deploying a tool 68/70 from within the well while the fluid is halted (col. 2, lines 31-40); allowing the tool to free fall in the well while the fluid is halted since the valve 100 is closed, in which this valve can be open or closed during operation to control the fluid flow which includes resuming flow or halting flow; but does not specifically disclose resuming the flow *to retrieve the tool*.

Kilgore shows a similar method which includes a well to deploy a tool 315 in “free fall” from within the well (col. 3, lines 42-44); allowing the tool to free fall in the well (col. 6, lines 64-67 & emphasis added *col. 3, line 44*); and utilizing the pressure of the fluid flow to retrieve the tool (col. 7, lines 1-6) utilizing a surface mechanism 470 that uses well pressure.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hawkins, as taught by Kilgore, to include the

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additional known method step of Kilgore to utilize the fluid flow to return a tool for the expected benefit of reusing tools by utilizing the recirculation pressure with the valve 100 of Hawkins already controls the fluid flow.

As concerns claim 26, the combination (Hawkins & Kilgore) show using the tool to take a corrective action in the well (col. 1, lines 40-45; col. 6, line 67 & col. 7, line 1, respectively).

As concerns claims 28, the combination (Kilgore) shows triggering the halting in response to a command (col. 5, lines 48-50).

As concerns claim 29, Hawkins shows triggering the halting in response to a previous measurement indicating intervention is needed in the well since Kilgore is capable of once a problem is detected (col. 7, line 1) another tool may be selected and utilized which will be dropped in free fall to its determined height using the computer 430.

3. Claims 12, 25, 44-48, and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. 6,302,199 and Kilgore 6,182,765, as applied to claim 10 above, further in view of Bijleveld et al 6,241,028. The combination shows the elements of claim 44 including the use of a spherical tool, but does not disclose the use of the tool as including a sensor. However, shows a similar tool 40 that is rolled into well (fig 3) that includes a sensor (fig 2) capable of collecting data, perform tests, and measuring properties of the well, along the well (claims 25 and 46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination, as taught by Bijleveld, to

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include a tool having sensor(s) for the expected result of improved operations utilizing collected data regarding the well and its properties.

As concerns claim 45, the combination (Hawkins & Kilgore & Bijleveld) shows introducing a delay that allows the tool to reach a certain depth.

As concerns claim 48, the combination (Hawkins & Kilgore) show using the tool to take a corrective action in the well (col. 1, lines 40-45; col. 6, line 67 & col. 7, line 1, respectively).

As concerns claim 50, the combination (Kilgore) shows triggering the halting in response to a command (col. 5, lines 48-50).

As concerns claim 51, Hawkins shows triggering the halting in response to a previous measurement indicating intervention is needed in the well since Kilgore is capable of once a problem is detected (col. 7, line 1) another tool may be selected and utilized which will be dropped in free fall to its determined height using the computer 430.

4. Claims 27 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. 6,302,199 and Kilgore 6,182,765 and Bijleveld et al 6,241,028, as applied to claim 10 above, further in view of Littleton et al 4,709,719 or Ashton 4,785,880. The combination does not disclose a timer; however, Littleton discloses control panel timer (col. 6, line 60) and Ashton with element 100 disclose the well known use of a timer to halt between tool launchings. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination, as taught by Littleton or Ashton, to include a timer for the expected result

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of improved operations by controlling the launch procedure of the tools in response to the known element of a timer.

Response to Arguments

5. Applicant's arguments regarding Kilgore and the Board decision are noted and applicant's arguments filed 10/15/09 have been fully considered but they are not persuasive.

Applicant's speculative piecemeal analysis of how the ball would be returned and how Hawkins could be operated to return the tool amounts to bodily incorporation arguments that are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Kilgore shows a surface mechanism 470 that uses well pressure to return a tool to the surface demonstrating the expected benefit of tool recovery being known (col. 2, lines 52-28) and that *given* the step of resuming flow it can be used to return a tool. It is not persuasive that applicant argues the secondary reference does not disclose "resuming" since the primary reference has already established "halting fluid flow" and "resuming flow" with valve 100; therefore, "resuming

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the flow” would innately be a step capable of Hawkins. The additional modification of utilizing of the known resumed fluid flow of Hawkins in order to return a tool is clearly shown by Kilgore. Furthermore, as newly cited art that was not applied (Robinson 2001/0045282; [0039]), additionally demonstrates that it is also known in the art to want to recovery balls and it is clearly known to be done, thus rendering applicants speculative analysis that the "size and shape" prevents returning of this tool.

6. In response applicant's arguments that the “cited art fails to set forth any type of arrangement to allow the ball to be retrieved” and “why there is even a need or desire to retrieve a ball from the well”, these arguments are not based in fact(s) and the rejection(s) above have demonstrated arrangement to return tools, i.e. balls, to the surface (see 470 of Kilgore) and the need to return tools, i.e. balls, to the surface for example to be reused or recovered as tools that include parameter data. Although the claims are interpreted in light of the specification, limitations from the specification and arguments are not read into the claims.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Beach whose telephone number is 571.272.6988. The examiner can normally be reached on Monday-Friday, 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571.272.6998. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Thomas A. Beach

/Thomas A Beach/

Primary Examiner, Art Unit 3671

September 16, 2010

THOMAS A. BEACH
Primary Examiner
Group 3600